

Office Action Summary

Application No.

10/522,412

Applicant(s)

BURCKHARDT, URS

Examiner

Patrick D. Niland

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/23/06.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 and 20-31 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 and 20-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some * c) ☐ None of:
 - 1. ☐ Certified copies of the priority documents have been received.
 - 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

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1. The amendment of 8/23/06 has been entered. Claims 1-18 and 20-31 are pending.
2. Claims 1-18 and 20-31 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the disclosed substituents, does not reasonably provide enablement for all of the encompassed substituents. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

A. The instant claims recite “substituted” without specifying what the substituents are. There are an infinite number of potential substituents many of which are not expected to function according to the instantly claimed invention. It would require undue experimentation to determine how to employ each of these substituents and to determine whether or not they will function in the instantly claimed invention.

The applicant’s reference to what “substituted” means and its common usage is not material to this rejection. The rejection does not question what “substituted” means. It is understood that it is commonly used. The examiner has given “substituted” its broadest reasonable interpretation above. Namely that “substituted” encompasses all known and yet to be discovered substituents. This is probably an infinite sized list. There is no general guidance as to how to choose substituents which will function in the instant invention from this list not to mention how to attach the various moieties encompassed by “substituted”. The instant specification gives no guidance as to how to choose the substituents encompassed by the instant claims which will function and those which will not function in the instant claims. It requires an infinite amount of experimentation to determine how to attach most of the moieties encompassed by the instant claims and another infinite amount of experimentation to determine which attached

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moieties will function in the instant invention. This is undue in that it is impossible to perform. The fact that the chemical arts are unpredictable would require significant guidance from the specification for the ordinary skilled artisan to be able to make substitutions which would function as required of the instant invention, i.e. one cannot predict with any degree of accuracy which substituents will and will not function according to the instant specification without testing them, e.g. testing an infinite sized list of substituents. The instant specification thus does not meet the test for enablement of the full scope of the instantly claimed "substituted" moieties as required by *In re Wands* at MPEP 2164.01 [R-5] Test of Enablement. The rejection is therefore maintained.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting

ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-18 and 20-31 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-25 of copending Application No. 10501074. Although the conflicting claims are not identical, they are not patentably distinct from each other because although the instant claims differ somewhat in scope, it would have been obvious to one of ordinary skill in the art at the time of the instant invention to practice the instant claims from the claims of the copending application because they overlap so much in scope. See copending claims 4-6 in particular.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented. The offered terminal disclaimer has not been filed and the applicant has not pointed out any reasons why the instant rejection is deficient. The rejection is therefore maintained until receipt of the offered terminal disclaimer.

5. Claims 1-18 and 20-31 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-21 of copending Application No. 10501078 in view of EP 477060 A1 Piestert et al., EP 469751 A1 Aoki et al., US Pat. No. 4469831 Bueltjer et al., US Pat. No. 4853454 Merger et al., and US Pat. No. 5116931 Reisch et al..

The copending claims encompass the instantly claimed inventions broadly. They do not recite the instantly claimed component B but the copending claim 21 encompasses using such compounds. It would have been obvious to one of ordinary skill in the art at the time of the

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instant invention to use the instantly claimed component B in the composition of the copending claims because it is encompassed by the copending claim 21 and Piestert shows such water containing compositions to be known for use in such curable compositions and the benefits disclosed by Piestert would have been expected in the copending claimed inventions. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the instantly claimed polyaldimines as the polyaldimines of the copending claims because they are encompassed by copending claim 11 and because such aldimines are well known for use in moisture cured polyurethane adhesive/sealants as shown by Aoki, the entire document particularly the aryl aldehyde aldimines which fall within the scope of the instantly claimed polyaldimines of claims 1 and 3, Bueltjer et al., the abstract and entire document which falls within the scope of the aldimines of the instant claims 1-2 and 4-6 and Merger et al., the entire document, particularly column 3, line 59 to column 4, line 10 which falls within the scope of the instant claims 4-6 where R sub 3 is the ester moiety and the attending moieties are those of the instant claims and they would have been expected to contribute their inherent curing properties to the compositions of the copending claims which encompass the use of such blocked amine curing agents.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use DMC to catalyze the polyethers of the prepolymers discussed above because this reduces production of monol, i.e. reduces unsaturation, which gives less chain termination and therefore raises the molecular weights and the modulus and the attending properties related to modulus and molecular weight. This is well known in the art at this point and is shown by Reisch et al.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The offered terminal disclaimer has not been filed and the applicant has not pointed out any reasons why the instant rejection is deficient. The rejection is therefore maintained until receipt of the offered terminal disclaimer.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

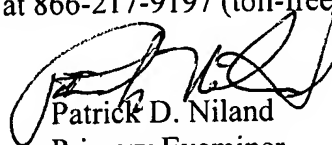
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Thursday from 10 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Patrick D. Niland
Primary Examiner
Art Unit 1714

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